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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/214,971	01/15/1999	GABRIELE VALENTE	30966.13USWO	7959
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GREENBERG TRAURIG LLP 2450 COLORADO AVENUE, SUITE 400E SANTA MONICA, CA 90404			EXAMINER CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 09/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/214,971

Applicant(s)

VALENTE, GABRIELE

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9,13,14,18,19 and 24-56 is/are pending in the application.
- 4a) Of the above claim(s) 37-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9,13,14,18,19 and 24-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESPONSE TO AMENDMENT

1. Claims 8, 9, 13, 14, 18, 19 and 24-56 are pending in the application, claims 37-56 have been withdrawn from consideration. Claims 1-7, 10-12, 15-17 and 20-23 have been cancelled.
2. Amendments to the claims, filed on July 6, 2005, have been entered in the above-identified application.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. §112, second paragraph, rejections of claims 8, 9, 13, 14, 18, 19 and 24-36, made of record in the office action mailed October 5, 2004, pages 4-5, paragraph #9 have been withdrawn due to Applicant's amendment in the response filed July 6, 2005.
4. The 35 U.S.C. §102 rejections made of record in the office action mailed October 5, 2004, pages 5-21, paragraphs #10-#12 has been withdrawn due to Applicant's amendment in the response filed July 6, 2005.
5. The 35 U.S.C. §103 rejections made of record in the office action mailed October 5, 2004 pages 22-27, paragraphs #13-21 has been withdrawn due to Applicant's amendment in the response filed July 6, 2005.

REJECTIONS

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Examiner's Comment

7. Applicant's have submitted a document from the U.S. Trademark web based Electronic Search System with the definition of the trade name SALPA. The document provides that the definition of SALPA is a material made from scraps of real leather from which may be manufactured various articles. Therefore, this definite of SALPA is a material made from scraps of real leather and Applicant's claim amendments are not considered new matter. It is noted though that Applicant should also amend the specification to include the definition of SALPA.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 8, 9, 24-31 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case amended claims 8 and 31 contain(s) the negative limitation "to provide a composite with only two materials." The specification does not disclose that extra layers are excluded from the composite, therefore this limitation is considered new matter. The specification specifically states that extra layers such as dyestuff layers, wool layers, nets and adhesive can be part of the composite (*specification page 4*).

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis

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for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. MPEP § 2173.05(i)

The new matter should be deleted.

Claim Rejections - 35 USC § 103

10. Claims 8, 9, 13, 14, 18, 19, 24-27 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch (U.S. Patent No. 4,849,145) in view of Tsui (U.S. Patent No. 4,325,236).

Hirsch discloses a leather like composite article (*col. 1, lines 8-12*).

Regarding Applicant's claim 8, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material in the form of a sheet of roll (*strip of leather or simulated leather, col. 5, lines 31-32*) and a covering layer including a film of polyethylene (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*), to provide a composite material of only two materials (*figure 1*). The materials being natural leather (*col. 5, line 31*) and the polyethylene film (*col. 5, lines 26-28*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

Furthermore, the reference discloses a method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the

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reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

Hirsch fails to disclose the supporting material is constituted by scraps of natural leather.

Tsui discloses a regenerated leather (*title*), i.e. synthetic leather, which comprises scraps of natural leather (*col. 1, lines 27-30*). The regenerated leather gives a realistic hand feeling as that of natural leather. If the regenerated leather is observed from the back side, it is no different to natural leather. The regenerated natural leather according to this invention can be used for the purpose of any natural leather (*col. 1, lines 35-40*).

Hirsch and Tsui are analogous because they both disclose imitation leather articles.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Tsui's regenerated leather as the simulated leather in Hirsch because they would have recognized that using scraps of leather is cheaper than real leather. One of ordinary skill in the art would have been motivated to use Tsui's regenerated leather because it has a realistic hand feeling as that of natural leather and if observed from the back side is no different than natural leather (*Tsui col. 1, lines 35-40*).

Regarding Applicant's claim 9, Hirsch discloses that the method of using the composite includes the step of cutting the composite material to form the product, since the reference discloses precutting the strips during formation of the product (*col. 4, lines 54-65*).

Regarding Applicant's claim 13, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material (*strip of leather or simulated leather, col. 5, lines 31-32*) in the form of a sheet of roll constituted, a covering surface

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layer including a polyethylene film (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

Furthermore, Hirsch discloses the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

It is noted that Hirsch fails to disclose the supporting material is constituted by scraps of natural leather. However, Tsui discloses these limitations as addressed above.

Regarding Applicant's claim 14, Hirsch discloses that the method of using the composite includes the step of cutting the composite material to form the product, since the reference discloses to precutting the strips during formation of the product (*col. 4, lines 54-65*).

Regarding Applicant's claim 18, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material (*strip of leather, col. 5, line 31*) in the form of a sheet of roll, a covering surface layer including a polyethylene film (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*). Natural leather being directly coupled to the film (*figure 1 and col. 4, lines 21-65*).

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The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

It is noted that Hirsch fails to disclose the supporting material is constituted by scraps of natural leather. However, Tsui discloses these limitations as addressed above.

Regarding Applicant's claim 19, Hirsch discloses that the method of using the composite includes the step of cutting the composite material to form the product, since the reference discloses to precutting the strips during formation of the product (*col. 4, lines 54-65*).

Applicant's claims 24-27 claim different ways of bonding the film layer to the leather. The method of forming the product is not germane to the issue of patentability of the method of using the product or the product itself. The determination of patentability for a method of using a product claim is based on the product itself and the method of using the product and not on the method of production. The method of forming the product is not germane to the issue of patentability of the method of using a product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art MPEP §2113. Furthermore, there does not appear to be a difference between the

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prior art structure and the structure resulting from the claimed method because Hirsch discloses a strip of natural leather bonded to a polyethylene film (*col. 5, lines 21-65*).

Regarding Applicant's claim 30, Hirsch discloses the composite includes forming a series of perforations (holes, *col. 6, lines 27-30*).

Regarding Applicant's claim 31, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material in the form of a sheet of roll (*strip of leather or simulated leather, col. 5, lines 31-32*) and a covering surface layer including a film of polyethylene (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*), to provide a composite material of only two materials (*figure 1*). The materials being natural leather (*col. 5, line 31*) and the polyethylene film (*col. 5, lines 26-28*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

Furthermore, the reference discloses a method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

Hirsch fails to disclose the supporting material is constituted by a mixture of a regenerated natural leather material.

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Tsui discloses a regenerated leather (*title*), i.e. synthetic leather, which comprises a mixture of regenerated scraps of natural leather (*col. 1, lines 27-30 and col. 2, lines 32-35*). The regenerated leather gives a realistic hand feeling as that of natural leather. If the regenerated leather is observed from the back side, it is no different to natural leather. The regenerated natural leather according to this invention can be used for the purpose of any natural leather (*col. 1, lines 35-40*).

Hirsch and Tsui are analogous because they both disclose imitation leather articles.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Tsui's regenerated leather as the simulated leather in Hirsch because they would have recognized that using scraps of leather is cheaper than real leather. One of ordinary skill in the art would have been motivated to use Tsui's regenerated leather because it has a realistic hand feeling as that of natural leather and if observed from the back side is no different than natural leather (*Tsui col. 1, lines 35-40*).

Regarding Applicant's claim 32, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material in the form of a sheet of roll (*strip of leather or simulated leather, col. 5, lines 31-32*) a covering surface layer including a polyethylene film (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

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Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

It is noted that Hirsch fails to disclose the supporting material is constituted by a mixture of a regenerated natural leather material. However, Tsui discloses these limitations as addressed above.

Regarding Applicant's claim 33, Hirsch discloses a method of using a composite material (*material having at least two layers, title*) comprising a supporting material (*strip of leather, col. 5, line 31*) in the form of a sheet of roll, a covering surface layer including a polyethylene film (*layer of synthetic resin, i.e. polyethylene, col. 5, lines 26-28*). Natural leather being directly coupled to the film (*figure 1 and col. 4, lines 21-65*).

The composite being for producing a product being selectively footwear soles and/or heels and/or vamps and/or toes, and/or suitcase elements and/or spectacle-cases and/or briefcases, and/or chair or sofa elements or structures or furniture or furnishing elements, since the reference discloses a great variety of different articles can be produced with the material such as small leather goods, suitcases, etc. (*col. 4, line 66 through col. 5, line 4*).

Furthermore, the method of using the composite material includes the step of forming the material into a shape to produce at least one of the products, since the reference discloses using the material to make three-dimensional articles by sewing, gluing, welding, and the like (*col. 1, lines 25-28*).

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It is noted that Hirsch fails to disclose the supporting material is constituted by a mixture of a regenerated natural leather material. However, Tsui discloses these limitations as addressed above.

11. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch in view of Tsui as applied above, and further in view of Nishimure et al. (U.S. Patent No. 3,958,057).

Hirsch and Tsui are relied upon as described above.

Hirsch and Tsui fail to disclose a dyestuff layer between the film and the leather.

However, Nishimure discloses a leather-like sheet comprising a pearl substrate layer, a colored layer, and a clear enameled porous sheet (*col. 3, line 54 to col. 4, line 30*). Where the colored layer is a dyestuff layer (*col. 4, lines 5-14*). The leather-like sheet material exhibits the ability to easily perform color matching (*col. 2, lines 1-9*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a dyestuff layer as taught by Nishimure between the support material and the film layer in the combination of Hirsch and Tsui. One would be motivated to do so in order enhance or change the color of the layer as desired for its intended use in order to have the ability to easily perform color matching.

12. Claims 29 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch in view of Tsui as applied above, and further in view of Hara (JP 404130172 A).

Hirsch and Tsui are relied upon as described above.

Hirsch and Tsui fail to disclose that the composite further includes a leather scent to the material.

Hara discloses a leather coat film with a leather perfume layer for better simulation of real leather (*Derwent abstract*).

It would have been obvious to one of ordinary skill in the art to add the leather perfume layer of Hara to the composite material of Hirsch and Tsui. One would be motivated to add the leather perfume to the composite material of Hirsch and Tsui in order to enhance the simulation of real leather.

The limitation “spraying” is a method limitation and does not determine the patentability of the method of using the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the method of using the product, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because the combination of Hirsch, Parrini, and Hara disclose a composite material with a leather scent.

ANSWERS TO APPLICANT'S ARGUMENTS

13. Applicant's arguments in the response filed July 6, 2005 regarding the 35 U.S.C. 112, second paragraph, 102 and 103 rejections of record have been considered but are moot since the rejections have been withdrawn.

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14. Applicant's arguments in the response filed July 6, 2005 regarding the 35 U.S.C. 112, first paragraph, of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the specification clearly provides for composite material constituting of two materials and is not new matter.

The examiner is not arguing that a two layer composite is new matter. The examiner is arguing that the exclusion of more than two layers is new matter.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

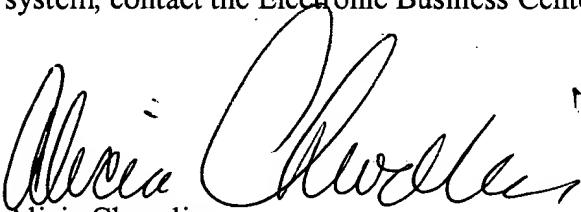
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alicia Chevalier

9/14/05